



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,893	10/02/2003	Robert C. Chang	SANDP040	2329
67813 7590 07/09/2009 BRINKS HOFER GILSON & LIONE/SanDisk P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER				
TSAL SHENG JEN				
ART UNIT		PAPER NUMBER		
2186				
MAIL DATE		DELIVERY MODE		
07/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: ROBERT C. CHANG, BAHMAN QAWAMI,
and FARSHID SABET-SHARGHI

Application 10/678,893
Technology Center 2100

Mailed: July 9, 2009

Before ERIC W. HAWTHORNE, *Supervisory Paralegal Specialist*
HAWTHORNE, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on August 28, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER

GROUND OF REJECTION TO BE REVIEWED UPON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed September 20, 2007 under the heading "Grounds of rejection to be Reviewed on Appeal" is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02* (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the last Office action and the Appeal Brief, and/or the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the Brief.

The following appealed claims were not included in the statement of rejection in the Answer as indicated in the last Office action mailed September 19, 2006 and the Appeal Brief filed July 4, 2007:

Claims 9 and 19 were rejected under 35 U.S.C. 103(a) as being anticipated by Bassett et al. (US 6,747,827), in view of Yada et al., (US Patent Publication 2002/0032891), and further in view of Kramer (US 6,182,239); and

Claim 17 was rejected under 35 U.S.C. 103 as being anticipated by Bassett et al. (US 6,747,827), in view of Yada et al., (US Patent Publication 2002/0032891), and further in view of Bruce et al. (US 5,956,743).

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

Accordingly, it is ORDERED that the application be returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed September 20, 2007;
- 2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection to be reviewed on appeal and to correct other sections of the Answer as may be required;
- 3) to include, if necessary, the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- 4) for further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

EWH/tdl

BRINKS HOFER GILSON & LIONE/SanDisk
P.O. BOX 10395
CHICAGO IL 60610